UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,759	06/23/2003	Kouji Kogusuri	00862.023097.	5724

5514 7590 06/19/2007

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
JONES, HEATHER RAE	

ART UNIT	PAPER NUMBER
2621	

MAIL DATE	DELIVERY MODE
06/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/600,759	KOGUSURI, KOUJI	
	Examiner	Art Unit	
	Heather R. Jones	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/653,956.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 10/653,956. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-13, 20, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A program is required to be stored onto a computer readable medium and claiming a storage medium is too broad of a term to be used for claiming a computer readable medium.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Harigaya et al. (U.S. Patent 5,583,791).

Regarding claim **1**, Harigaya et al. discloses an image playback apparatus comprising: a playback device adapted to play back from a recording medium a plurality of image files each having motion image data (abstract; col. 3,lines 63-64); a display device (36) having a function of displaying on the same screen representative images of a plurality of image files recorded on the recording medium by using the image files played back by the playback device (Fig. 3; col. 5, lines 54-56); a selecting device adapted to select a desired representative image from the plurality of representative images displayed on the display device (col. 9, lines 16-21); and a control device adapted to control the playback device and the display device such that a display form of the representative image

selected by the selecting device differs from a display form of other representative images (col. 9. lines 16-21 – once an image is selected it is then displayed on the whole screen rather than just a portion).

Regarding claim **2**, Harigaya et al. discloses all the limitations as previously discussed with respect to claim 1 including that the image file has an audio data corresponding to the motion image data and the control device controls the playback device so as to play back the audio data of the image file corresponding to the selected representative image and to output to a speaker device (col. 7, lines 1-3; col. 10, lines 33-41 – video and audio are reproduced, but while there are more than one image on the screen no audio is reproduced, therefore once the image is selected then the audio will be played back with it).

Regarding claim **3**, Harigaya et al. discloses all the limitations as previously discussed with respect to claim 1 including that the control device controls the playback device and the display device such that a playback frame rate of the selected representative image differs from a playback frame rate of the other representative images (col. 7, lines 11-34).

Regarding claim **4**, Harigaya et al. discloses all the limitations as previously discussed with respect to claims 1 and 3 including that the control device makes the playback frame rate of the selected representative image higher than the playback frame rate of the other representative images (col. 7, lines 11-34).

Regarding claim **6**, Harigaya et al. discloses all the limitations as previously discussed with respect to claim 1 including that the control device determines a playback frame rate of the plurality of representative images in accordance with the number of the representative images to be displayed on the same display screen (col. 7, lines 11-34).

Regarding claims **7-9**, these are method claims corresponding to the apparatus claims 1-3. Therefore, claims 7-9 are analyzed and rejected as previously discussed with respect to claims 1-3.

Regarding claims **10** and **11**, these are program claims corresponding to the method claims 7 and 9. Therefore, claims 10 and 11 are analyzed and rejected as previously discussed with respect to claims 7 and 9.

Regarding claims **12** and **13**, these are storage medium claims corresponding to the program claims 10 and 11. Therefore, these claims are analyzed and rejected as previously discussed with respect to claims 10 and 11.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harigaya et al. as applied to claims 1 and 3 above.

Regarding claim **5**, Harigaya et al. discloses all the limitations as previously discussed with respect to claims 1 and 3, but fails to include that the control device displays the selected representative image as a motion image, and the other representative images as still images. Official Notice is taken that a menu screen can consist of still and motion images. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a menu screen with still and motion images to allow the motion images to have a faster frame rate.

9. Claims 14, 15, 17, 18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harigaya et al. (U.S. Patent 5,583,791) in view of Sakagami et al. (U.S. Patent 5,497,194).

Regarding claim **14**, Harigaya et al. discloses an image recording/playback apparatus comprising: a recording medium adapted to record a main sound input from the sound input device while the motion image is being sensed, and the motion image sensed by the image sensing device; a display device (36) having a function of displaying, in a predetermined array form, a list of representative images of a predetermined number of image files of a plurality of image files recorded on the recording medium (Fig. 3; col. 5, lines 54-56); a selecting device adapted to select at least one of the representative images of the predetermined number of image files displayed on the display device (col. 9, lines 16-21); a sound playback device adapted to play back the sound recorded on the recording medium; and a control device which, when at least one image is

selected by the selecting device, controls the sound playback device to play back the main sound corresponding to the selected image file (col. 9. lines 16-21 – once an image is selected it is then displayed on the whole screen rather than just a portion). However, Harigaya et al. fails to disclose an image sensing device adapted to sense a motion image; a sound input device adapted to input a sound; a recording medium adapted to record a sub sound input from the sound input device in an image sensing standby state for the motion image; and wherein the sub sound is played back when the corresponding image file is selected.

Referring to the Sakagami et al. reference, Sakagami et al. discloses an image recording/playback apparatus comprising: an image sensing device adapted to sense a motion image (14); a sound input device adapted to input a sound (16); a recording medium (12) adapted to record a sub sound input from the sound input device in an image sensing standby state for the motion image; and wherein the sub sound is played back when the corresponding image file is selected (Fig. 1; col. 2, lines 25-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sub sound detailing the selected image as disclosed by Sakagami et al. with the apparatus as disclosed by Harigaya et al. in order to further establish that the user is selected the image they desire.

Regarding claim **15**, Harigaya et al. in view of Sakagami et al. discloses all the limitations as previously discussed with respect to claim14, including that if no sub sound is recorded, the control device plays back a main sound corresponding to the selected image file (Sakagami et al.: Fig. 1; col. 2, lines 25-31 – records the sub sounds; Harigaya et al.: col. 7, lines 1-3; col. 10, lines 33-41 – video and audio are reproduced, but while there are more than one image on the screen no audio is reproduced, therefore once the image is selected then the audio will be played back with it – if no sub sound is provided then the main sound will be played once the image is selected).

Regarding claims **17** and **18**, these are method claims corresponding to the apparatus claims 14 and 15. Therefore, claims 17 and 18 are analyzed and rejected as previously discussed with respect to claims 14 and 15.

Regarding claim **20**, this is a program claim corresponding to the method claim 17. Therefore, claim 20 is analyzed and rejected as previously discussed with respect to claim 17.

Regarding claim **21**, this is a storage medium claim corresponding to the program claim 20. Therefore, claim 21 is analyzed and rejected as previously discussed with respect to claim 20.

10. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harigaya et al. in view of Sakagami et al as applied to claims 14 and 15 above, and further in view of Anderson et al. (U.S. Patent 7,117,519).

Regarding claim **16**, Harigaya et al. in view of Sakagami et al. discloses all the limitations as previously discussed with respect to claims 14 and 15, but fails to disclose further comprising a display device which demands recording of a sub sound if no sub sound is recorded.

Referring to the Anderson et al. reference, Anderson et al. discloses an image recording/playback apparatus further comprising a display device which demands recording of a sub sound if no sub sound is recorded (col. 10, lines 5-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have prompted the user to add a sub sound if was not provided as disclosed by Anderson et al. with the Harigaya et al. in view of Sakagami et al. in order to allow the user add a sub sound after the recording since the user may not have wanted one beforehand, which makes the apparatus more user friendly.

Regarding claim **19**, this is a method claim corresponding to the apparatus claim 16. Therefore, claim 19 is analyzed and rejected as previously discussed with respect to claim 16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-

7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Heather R Jones
Examiner
Art Unit 2621

HRJ
June 11, 2007